REMARKS/ARGUMENTS

This amendment is submitted in response to the Office Action dated September 23, 2005. Reconsideration and allowance is requested.

Claims 1, 5-10, 23-25, 27 and 33 remain in this application. Claims 2-4, 11-22, 26, and 28-32 have been canceled.

Claim Rejection Under 35 USC 103

In the Office Action, the Examiner rejected claims 1-11, 23-25, 28 and 33 under 35 USC 103(a),as being unpatentable over Stephan et al (U.S. 6,338,001 B1) in view of Hance (U.S. 6,574,359 B1) and further in view of Chen (U.S. 5,862,055), and further in view of Gleason et al (U.S. 5,456,899 B1), further in view of Nishimura et al (U.S. 6,456,899 B1), further in view of Kumagai (U.S. 5,394,481) and still further in view of Jarvis et al (U.S. 6,297,644 B1). The Applicants respectfully traverse.

In order to establish *prima facie* obviousness three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all of the claimed limitations. The teachings or suggestions to make the claimed invention and the reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure. See In re Vaeck 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) And MPEP 2143. The Applicants respectfully submits that the Examiner has not satisfied all three criteria outlined in MPEP 2143.

First, counsel for assignee does not believe that the prior art references (or references when combined) teach or suggest all of the claimed limitations. For example, in section 2e of the Office Action, the Examiner argued:

> e. displaying on a screen said extracted defect candidate image together with first and second classification information, said first classification information relating to said first category, said second classification information relating to said second category;

> (See figure 4, noting that it would have been obvious for the image data to be presented along with the defect data and kill ratio data, for example, which describes it, as one ordinarily skilled in the art would recognize that effective review and comparison of the chip defects with what an ideal example of such chip features should be (see col. 4, lines 65-67 and col. 5, lines 1-10) would require a visual representation of the particular defect so that appropriate changes can be made to the process or design of the chip);

Counsel for assignee respectfully disagrees with the Examiner's reasoning why a visual representation of a particular defect would be required. In fact the reference cited by the Examiner makes absolutely no reference to displaying a visual representation and only mentions displaying the defect information for the user to see. As one skilled in the art would appreciate, defect information can include many different measurements including voltage data, thickness data, magnetic data, resistivity data, etc., which do not require examining a visual representation of the image to make a decision as asserted by the Examiner. Therefore, counsel for assignee does not believe that all of the elements of the claimed invention have been disclosed in the prior art for at least this reason.

Second, counsel for assignee does not believe there is any suggestion or motivation for modifying the prior art teachings, as suggested by the Examiner, to include a visual representation of a particular defect. Specifically, as mentioned above, the Examiner argued "one ordinarily skilled in the art would recognize that effective review and comparison of the chip defects with what an ideal example of such chip features should be (see col. 4, lines 65-67 and col. 5, lines 1-10) would require a visual representation of the particular defect so that appropriate changes can be made to the process or design of the chip." Counsel for assignee respectfully disagrees with this reasoning because one skilled in the art wishing to automate a system, as Steffan does, would probably wish to remove all aspects related to human inspection of an image out of the defect analysis procedure because if human inspection were required, as suggested by the Examiner, then the process would probably not be automatic. Counsel does not believe that there is any motivation or suggestion to modify the teachings of Steffan, as suggested by the Examiner, for at least this reason.

Nevertheless, claims 1, 6, and 9 have been amended to ***further*** distinguish them from Stephan, Hance, Chen, Gleason, Nishimura, Kumagai, and Jarvis. Claims 1 and 6 have been amended to include the limitation "displaying on a screen said extracted plural defect candidate images side by side together with their first and second classification information" whereas claim 9 has been amended to include the limitation "displaying on a single screen a distribution on said inspected object of said defect candidates classified in said first category in a map format together with first and second classification information." Support for these amendments can be found throughout the originally filed specification and specifically in FIG. 18 and its associated description. Additionally claim 1 has been amended to include the limitations found in dependent claims 2 and 4 whereas claim 9 has been amended to include the limitations found in dependent claims 26 and 28. None of the prior art teach suggest or allude to displaying plural defect images on a screen side by side together with their ID data and plural classification data. Therefore, counsel for assignee believes the amended claims are not obvious.

Therefore, in light of the above amendments and remarks counsel for assignee believes that the claimed invention is not obvious under Stephan in view of Hance and further in view of Chen, and further in view of Gleason, further in view of Nishimura, further in view of Kumagai, and still further in view of Jarvis.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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